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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/726,744

12/02/2003

Larry C. Olsen

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EXAMINER

BARTON, JEFFREY THOMAS

ART UNIT

PAPER NUMBER

1728

NOTIFICATION DATE

DELIVERY MODE

02/23/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<p><b>Application No.</b> 10/726,744</p>	<p><b>Applicant(s)</b> OLSEN ET AL.</p>	
	<p><b>Examiner</b> Jeffrey T. Barton</p>	<p><b>Art Unit</b> 1728</p>	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 07 February 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 07 February 2011. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☒ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). 20110207  
13. ☐ Other: \_\_\_\_\_.

/Jeffrey T. Barton/  
Primary Examiner, Art Unit 1728

Continuation of 11. does NOT place the application in condition for allowance because: Applicant continues to argue that the Bottner reference is non-enabling, and submits an evaluation of the reference based on the Wands factors. It is noted that the Bottner reference is cited as teaching known non-stoichiometric  $(\text{Bi,Sb})_2\text{Te}_3$  thermoelectric compositions that correspond to the claim limitations, as opposed to any particular method. (e.g. Figures 11a and 11b) The method considerations are considered largely outside the scope of the instant product claims which are only limited to the structure recited. However, as to the Wands factor treatment submitted, it is further noted that this is in significant error in several aspects. In particular applicant asserts that "there are no examples in the Bottner reference showing or describing how to make the claimed compounds or thin film thermoelements". This is simply incorrect. The cited figures show numerous working examples of non-stoichiometric compositions as claimed, and the reference teaches coputtering of the materials from elemental targets onto heated or non-heated substrates. The question of whether experimentation needed would be undue was addressed in the previous office action in detail. Even if such considerations are given weight in determining patentability of these product claims, based on the teachings of Mattox the experimentation required to select appropriate deposition parameters within the sputtering method of Bottner is not considered to have been undue, as it is conventional in the field to monitor and vary these parameters in developing sputtering methods. Applicant fails to address the cited portions of Mattox in the response. As to the status of Declarant McClelland as an expert in the field, the examiner has no doubt as to his expert status in the field of PVD. This does not mean that his positions concerning the legal determination of whether experimentation required to prepare a composition would be undue are not to be questioned. Applicant has not addressed the Examiner's explanation as to why the declaration is not persuasive. Applicant's arguments concerning claim 3 do not address the rejection made. Applicant is encouraged to review the office action. Applicant's concerns regarding claim 5 have been treated numerous times in the preceding office actions, and the Examiner's position remains the same. No evidence of unexpected results have been provided by Applicant. All rejections are considered to be proper and are maintained.